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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Group No.: 3643

MILLER et al.

Application No.: 10/806,223

Confirmation No.: 1747

Filed: March 23, 2004

Examiner: Rowan, K.

Title: COUNTERFLOW INSECT TRAP

**Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
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REPLY BRIEF ON APPEAL

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I. INTRODUCTION

The Examiner's Answer fails to address many of Applicants' arguments. To the extent it does address certain arguments, the Answer is wholly conclusory, relies on no evidence in support of its claims of inherency, and makes no reference to the claim language. These omissions highlight the deficiencies in the appealed rejections, and support the Applicants' position that the Examiner should be reversed.

II. ARGUMENT

First and foremost, the Answer has not provided even one word of response to Applicants' arguments regarding commercial success. While Applicants continue to dispute that a proper *prima facie* case of obviousness has been set forth, even if one had been, it is overcome by Applicants' un-rebutted evidence of commercial success. Specifically, the Applicants have convincingly shown that their invention was extremely successful despite being priced 10-25 times higher than competing products. Moreover, the International Trade Commission found the products to be commercially successful. In response, the Examiner's answer is silent. On the basis of commercial success alone, the claims should be allowed.

Second, there is no response in the Answer to Applicants' point that there is no specific rejection of many of the application claims. (See, e.g., IV(C)(2)(b, d, f, h, h¹, and j)). Indeed, many of these are never even discussed by the Examiner anywhere in the prosecution history. Because no *prima facie* case of obviousness has been made with respect to these claims, Applicants submit that they should be allowed.

Third, the Answer relies on inherency² in making the assertion that "Cheshire inherently suggest [sic] the counterflow relationship between the inflow and the outflow since air is pulled into the trap, air must be blown out of the trap." While the assertion that air coming in means air is going out appears to Applicant to be logically true, this is not what is claimed and highlights the Answer's lack of any reference to claim language. The counterflow of Applicant's claims requires more than simply air moving in and out of the trap. For example, the explicit language of claim 1 defines counterflow as inflow and outflow having overlapping regions and that the flow be adjacent the overlapped region.

¹ Applicant notes that due to a clerical error, (h) and (i) appear to have been repeated in the Brief.

² It should be noted that any rejection based on inherency requires more than a statement that the recited limitation is inherent, it requires evidence that the allegedly inherent feature is "necessarily present" in the reference. (See, MPEP 2112, IV). The Answer provides no such evidence.

(*See, e.g.*, IV(C)(2)(a)(i) of Applicants' Appeal Brief). The Answer does not assert anywhere that the inflow and outflow of Cheshire are adjacent at an overlapped region. The only statement regarding overlapping regions is conclusory (see p. 4, six lines from end) and makes no reference to evidence in support of the alleged inherent overlapping region. Allegations of inherency in the absence of any evidence in support thereof are not a sufficient basis to maintain the rejection.

Similarly, claim 83 recites that, "outside said device, said inflow extends substantially to or below an elevation of the outflow opening." The Examiner has never addressed this claim limitation, and has failed to point to any reference teaching or suggesting it.

Fourth, the Answer provides no rebuttal to Applicants' arguments regarding the claim limitation "an insect attractant dispersed therein." (*See, e.g.*, pp. 13 and 14 of Applicants' Appeal Brief). In particular, Applicant provided reasons, including the Board's previous decision in the grandparent application, that the light and heat of Cheshire cannot be considered to be "an insect attractant dispersed [in the outflow]." The Answer, rather than address this issue, merely makes the observation that "if light can be considered to be in the [sic] outflow, some of the claims can be interpreted to be anticipated by Cheshire." As an initial matter, this statement raises the question of what claims the phrase "some of the claims" refers to. Additionally, there is no support given for the proposition that light can be considered to be in the outflow. Indeed, the Examiner fails to cite to a single shred of evidence to rebut the Applicants' position (and more importantly, this Board's decision on the same issue in the grandparent application). Thus, the Examiner's reliance on Cheshire in this respect cannot be supported.

Finally, Applicant takes the Examiner's statement of the grounds of rejection omitting any mention of double patenting, along with the Answer's failure to address the question of double patenting to mean that this ground of rejection has been withdrawn.

III. CONCLUSION

For at least the reasons discussed above, it is respectfully submitted that claims 1-123 are not rendered obvious by the cited references and that the Terminal Disclaimer filed previously overcomes the double patenting rejection. For the above reasons, Applicants respectfully request this Honorable Board to reverse the rejections of the claims.

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